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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,060	08/17/2001	Joseph Gubernick	2870/536	5059

7590 06/02/2003
Karen A Lowney Esq
Estee Lauder Companies
125 Pinelawn Road
Melville, NY 11747

EXAMINER

DOAN, ROBYN KIEU

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 06/02/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,060

Applicant(s)

GUBERNICK, JOSEPH

Examiner

Robyn Doan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 29 is/are allowed.
- 6) ☐ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's Amendment filed 03/12/2003 has been entered and carefully considered. Claims 1-2, 6-8, 13-14 and 29 have been amended. Claim 29 is allowable over prior art, however, limitations of amended claims have not been found to be patentable over prior art of record, therefore, claims 1-28 are rejected under the same ground rejections as set forth in the Office Action mailed 12/13/2002.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 6-7, 11-12, 15 and 17-19 and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Israel et al.

With regard to claims 1-2, Israel et al discloses a case (figs. 1-2) comprising a surface (28) having one or more grooves (recess 26 fig. 1), openings toward the tops of one or more grooves and at least one cosmetic powder (40) disposing in the groove. The method used to form the powders by extruding is given no patentable weight. In regard to claims 6-7, the grooves being integrally made with the surface (28), the method used to form the grooves by molding with the surface or by cutting into the

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surface is given no patentable weight. In regard to claims 11-12, Israel et al shows one of the grooves being closed at both ends (at 26 fig. 1) and one divider (top surface 28 between groove 24 and groove 26) adapting to separate the extruded powders. In regard to claims 15, 17-19, the cross sectional shape of each groove matching the cross sectional shape of the extruded powders, wherein the cross sectional shape of the grooves being rectangular (fig. 1); the case further having a surface comprising a section without grooves (at 22), this section holding a mirror (22). In regard to claims 26-28, the case also having a cover (14) being hinged to the surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al in view of von Kleinsorgen.

With regard to claims 3-5, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above except for the powders being not all the same color and chemical composition and forty percent or more of each powder rises above the surface. Von Kleinsorgen discloses a cosmetic stick (fig. 1) comprising at least two

powders (12, 13) being not all the same color and chemical composition (col. 4, lines 19-22) and wherein the powder of each chemical composition being arranged in section (fig. 1), each section holding one chemical composition. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the particular powder as taught by von Kleinsorgen into the case of Israel for the purpose of providing a plurality different colors.

Claims 8-9 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al in view of Schefer.

With regard to claims 13-14, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above except for a portion of the powders or forty percent or more of the powders rises above the surface, one or more restraints that inhibiting the powders from coming out of the grooves and wherein the grooves openings being slightly smaller than the extruded powders. Schefer discloses a cosmetic compact case (fig. 6) comprising a surface (30) having a plurality of grooves, a portion of cosmetic powder (24) rises above the surface (fig. 6), the case further having one restraint (22). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the restraint as taught by Schefer into the case of Israel et al for the purpose of inhibiting the powders from coming out of the grooves and it would also have been an obvious matter to one having an ordinary skill in the art at the time the invention was made to construct wherein the grooves openings being slightly smaller than the powders, since it has been held that discovering an

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optimum value of a result effective variable involves only routine skill in the art and it would also have been an obvious matter to one having an ordinary skill in the art at the time the invention was made to construct forty percent or more of each powder rises above the surface, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Claims 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel in view of Gueret.

With regard to claims 20-25, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above except for an outer container having a section holding a mirror and a cover being hinged to the outer container. Gueret discloses a cosmetic compact case (fig. 1) comprising an outer container (1) having a cover (c) being hinged to the container (13) and a mirror (14). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the outer container as taught by Gueret into the case of Israel et al for the reusable purpose.

Applicant has argued the difference in compositions of extruded powders and pressed powders; however, Applicant fails to show the different amounts of binders used in pressed and extruded powders. The extruded process of forming powder is not given any weight in the article claim. The only difference between the final extruded and pressed powder appears to be a degree of binder used and the disclosure is not

specific as to what this difference in the degree of binder used is; without this teaching, the degree of binder used is broadly claimed and is held to be met by the prior art.

Claim 29 is allowable over prior art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (703) 306-9182. The examiner can normally be reached on Mon-Fri 9:30-7:00; alternate Mondays off.

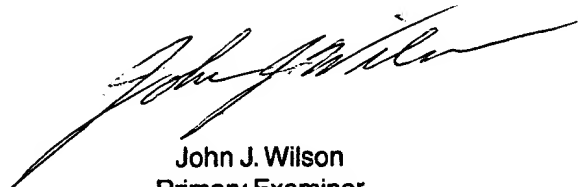
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Robyn Kieu Doan
Examiner
May 31, 2003



John J. Wilson
Primary Examiner